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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,555	11/25/2003	Tomoyuki Shobu	105-78	5837

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EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/721,555

Applicant(s)

SHOBU ET AL

Examiner

David M Brunsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Zero MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to a shellac coating agent, classified in class 106, subclass 238+.
- II. Claims 13-18, drawn to a process of making I, classified in class 366, subclass 69+.
- III. Claims 19-22, drawn to a coated food, classified in class 426, subclass 89+.
- IV. Claims 23-29, drawn to a coated drug, classified in class 424, subclass 500+.
- V. Claims 30-41, drawn to a glaze, classified in class 106, subclass 217.4+.
- VI. Claims 42-49, drawn to a glazing method and glazed confectionary made thereby, classified in class 426, subclass 103+.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product could be made by a materially different process such as one wherein neat basic amino acid or phosphate is added to a shellac suspension.

Inventions I(and the process of making it II) and III are related as mutually exclusive species in an intermediate-final product relationship as in use the intermediate of I bonds to the substrate in III and changes characteristics. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an agent to coat drugs and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the

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ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions I(and the process of making it II) and IV are related as mutually exclusive species in an intermediate-final product relationship as in use the intermediate of I bonds to the substrate in IVI and changes characteristics. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an agent for coating food and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions I(and the process of making it II) and V are related as mutually exclusive species in an intermediate-final product relationship as in use the thickener added in V materially affects the structure of the aqueous solution of the intermediate of I. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an agent for coating drugs and the inventions are deemed

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patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions V (and its intermediate I and process of making II) and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product could be used in a process of glazing inedible objects.

Inventions III, IV and V (including its subsequent use VI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and though containing a common ingredient are disclosed as capable of use together. That is one is disclosed as for coating a food article, one for coating a drug and one to be converted into glaze for glazing an oil based confectionary.

Claims 1-49 are generic to a plurality of disclosed patentably distinct species. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. The species from which election is required are set forth below as dependent upon the group (I-VI) chosen in the restriction above.

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

If group I is selected, applicant must elect a single disclosed compound or mixture of compounds from those recited in claims 2 and 3 (e.g. "lysine") and must elect none or a single compound or mixture of compounds from those recited in claims 8-12 (e.g. "triethyl citrate").

If group II is selected, applicant must elect which species of process type is to be initially examined from among that of claim 13 wherein shellac is mixed with a solution of basic amino acid of phosphate and that of claim 14 wherein shellac is mixed with an acidic material and then a basic alkali metal salt is added. In addition applicant must elect a compound as from claims 2 or 3 as in group I, above, or if the process of claim 14 is selected, an alkali metal salt species as recited in claim 15 and an acidic material species as recited in claim 16.

If group III is selected, applicant must elect an article comprising a single layer or a multilayer wherein the applicant must further elect a single additional material or mixture of materials selected from those recited in claim 21 (e.g. a multilayered article wherein the "other coating agent" is "zein").

If group IV is selected, applicant must elect an article comprising a single layer or a multilayer wherein the applicant must further elect a single additional material or mixture of materials selected from those recited in claim 27 (e.g. a multilayered article wherein the "other coating agent" is "chitosan").

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If group V is selected, applicant must elect single disclosed compound or mixture of compounds from those recited in claims 31 and 32 (e.g. "lysine") and must elect none or a single compound or mixture of compounds from those recited in claims 8-12 (e.g. "triethyl citrate) **and** a single compound or mixture of compounds from those recited in claim 36 **and** a single material or mixture from a) those recited in claim 37 or b) those recited in claim 40.

If group VI is selected, applicant must elect a single disclosed oil based confectionary to be glazed from those recited in claim 49 as well as the glaze components that would be required from group V above.

Upon election, the examiner will expand the scope of consideration, if appropriate, to be commensurate with that required for proper search and consideration of the elected species without undue burden upon the office.

Due to the complexity of this requirement, a telephone election was not attempted. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunsman  
Primary Examiner  
Art Unit 1755



DMB